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| 10/817,119  | 04/02/2004  | Jeff Poulos          | OTR-A-US                        | 2900             |
| 31621   | 7590        | 01/12/2009           |                                 |                  |
| HARVEY LUNENFELD<br>8 PATRICIAN DRIVE<br>E. NORTHPORT, NY 11731 |             |                      | EXAMINER<br>MENDIRATTA, VISHU K |                  |
|   |             |                      | ART UNIT                        | PAPER NUMBER     |
|   |             |                      | 3711                            |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/817,119

**Applicant(s)**

POULOS, JEFF

**Examiner**

Vishu K. Mendiratta

**Art Unit**

3711

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-7, 9-24 in the reply filed on 11/1/08 is acknowledged. Claim 8 has been withdrawn from consideration.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 9-24 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Limitations are abstract with no concrete conclusion that can be used in a repeated manner for a viable game. Method steps are ambiguous, imaginary or verbal with no physical transformation (example: players commit secretly to a strategy, some combination of the results). Limitations (example claim 3) are bits and pieces of rules with no clear methodology to practice and arrive at a concrete conclusion for repeatability of the method.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7, 9-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Some examples of indefiniteness are produced below. Applicant is required to review all claims and make necessary corrections.

(Claim 1) In the absence of clearly and positively providing environment/apparatus and method steps that can be clearly repeated to arrive at a concrete conclusion it is not possible to practice a method in a consistent manner. Method of playing as claimed is indefinite.

(Claim 2) In the absence of clearly and positively providing environment/apparatus and method steps that can be clearly repeated to arrive at a concrete conclusion it is not possible to practice a method in a consistent manner. Method of playing as claimed is indefinite. Limitations "as by placing cards/turning cards", "players commit secretly to a strategy", "some combination of the results.....charts to consult" are indefinite and having no antecedent basis in the claim.

(Claims 3, 4, 5) The claim is narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The method of playing and structure must be organized and correlated in such a manner as to present a complete operative device and method that can be practiced by players on ground. Limitations (example claim 3) are bits and pieces of rules with no clear methodology to practice and arrive at a concrete conclusion for repeatability of the method. Limitations have no clear coordination between various steps for a clear flow in practicing the method, no clear sequence of steps, introducing terminology with no antecedent basis (example claim 3: one additional iteration, a set configuration, example claim 4: achieve a return action,

example claim 5:each group of ten markings ). **Claims are required to stand on their own and not required to be read into the specification.**

(Claims 6, 7) In the absence of clearly and positively providing environment/apparatus and method steps that can be clearly repeated to arrive at a concrete conclusion it is not possible to practice a method in a consistent manner. Claim 6: Limitations "occasional special.....event occurs" are run-on with no clear methodology that can be practiced by players on ground. Claim 7: establishing a toggle value has no clear meaning. All limitations are run-on with bits and pieces of rules that can not be practiced without concrete conclusion in a repeated manner.

5. Claims 1-7, 9-24 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: There are no steps to practice a viable game by players on ground.

6. Claims 1-7, 9-24 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Example claim 3: How is the configuration being established on a board? Perhaps (!) game pieces or miniatures are placed on the game board. The claim does not provide any such structure to accomplish configuration. Where is the board being used (?) in so called method of playing a board game in claim 1, 2, 6 and several other dependent claims.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3, 4, 5, 6, 9, 12, 13, 14, 15 rejected under 35 U.S.C. 102(b) as being anticipated by Sheridan (4443011).

Claim 1: Sheridan teaches a method of playing a game wherein dice are repeatedly and continued through at least two sub-plays until one side wins the play (21:16-22:56).

Claim 10: Sheridan teaches sport being football.

Claims 3, 4, 5, 6, 9, 12, 13, 14, 15: Sheridan teaches initial positioning of first and second teams (Fig.5, 4:42-45), prescribing a playing time (20:57-60) inherently using and starting a clock or a watch (20:25-30), a method of playing a game wherein dice are repeatedly and continued through at least two sub-plays (21:16-22:56) and modifying team positions according to the result of the rolling as a matter of contest (19:61-20:22). Limitations achieve a return, using clock starting and stopping is commonly known football terminology and inherent in the reference cited.

9. Claims 2, 11 rejected under 35 U.S.C. 102(b) as being anticipated by Hutchinson (5762338).

Claims 2, 11: Hutchinson teaches two opponents secretly making football strategy (6:21-32) using cards, rolling dice (1:14-21), and determining result of the strategy of the two opponents using a chart (1:43-45).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 16, 17, 18, 19, 21, 22, 23, 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Sheridan in view of Hamilton (4669526).

Sheridan teaches all limitations except that it does not teach playing a dice game with other sports such as soccer, golf, racing, and boxing. Hamilton teaches playing dice games in the environment of soccer, racing, golf and boxing. In order to make the game attractive to potential players, it would have been obvious to use other environments as soccer, boxing, racing and golf. One of ordinary skills in art at the time the invention was made would have suggested playing dice game in other environments as soccer, racing, boxing and golf to attract potential players.

12. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchinson in view of Hamilton (4669526).

Hutchinson teaches all limitations except that it does not teach playing a dice game with other sports such as golf. Hamilton teaches playing dice games in the environment of golf. In order to make the game attractive to potential players, it would have been obvious to use other environments. One of ordinary skills in art at the time the invention was made would have suggested playing dice game in other environments as golf to attract potential players

13. Claims 3, 4, 5, 9, 12, 13, 14, 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Sheridan.

Claims 3, 4, 5, 9, 12, 13, 14, 15: Sheridan teaches initial positioning of first and second teams (Fig.5, 4:42-45), prescribing a playing time (20:57-60) inherently using and starting a clock or a watch (20:25-30), a method of playing a football game wherein dice are repeatedly and continued through at least two sub-plays (21:16-22:56) and modifying team positions according to the result of the rolling as a matter of contest (19:61-20:22).

Applicant may argue that Sheridan does not teach using a clock for repeating start and stop of game, achieve a return and other football game rules.

Limitations achieve a return, using clock starting and stopping is commonly known football terminology and inherent in the reference cited.

In order to simulate a real football game, it would have been obvious to use commonly known football rules in the game. One of ordinary skills in art at the time the invention was made would have suggested using commonly known terminology and rules to simulate a real football game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vishu K Mendiratta/  
Primary Examiner, Art Unit 3711

Vishu K Mendiratta  
Primary Examiner  
Art Unit 3711

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